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EXAMINER

FRISBY, KESHA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,755	Applicant(s) WASOWICZ ET AL.	
	Examiner Kesha Frisby	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-64 and 66-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-64 and 66-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/14/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

After the preliminary amendment filed on 11/14/2003, claims 1-47, 65 & 95-481 have been cancelled. Therefore, claims 48-64 & 66-94 are pending.

Priority

1. The applicant is requested to update the status of any application, specifically application number 09/912681, recited in the first line of the specification.
2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. 09/350791 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Information Disclosure Statement

3. The information disclosure statement filed 11/14/2003, in regards to the International Search Report for PCT/US03/03146 dated July 11, 2003 was not included

in the file fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 72, 73 & 75 lack antecedent for "the recommender" and claims 76 & 88-93 lack antecedent basis for "the teacher station".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 48, 49, 52-57, 59, 62, 66-68, 70-76, 80-85 & 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Corder (US 5,692,906).**

Regarding Claim 48, Corder discloses instructions for one or more tests for determining deficiencies in one or more reading and pre-reading skills (e.g., testing the student's ability to reproduce, recognize, pronounce, spell, and translate, communication skills necessary for use of the English language, rules of grammar & column 1 lines 28-33);

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instructions for determining a score for each test (Col. 3:42-53, Col.6: 14-17, 32, Col.7: 51-52, Col.12: 18-25 and Col.13: 32-41); instructions that cause a student computer to display (i.e., student's workstation) at least one of a graphical image and audio associated with each test based on the instructions on the portable media (FIG. 2(b) and Col.3: 25-28); instructions that receive a user response (e.g., voice recording device 262) to one of the graphical images and audio presented by each test and instructions (e.g., AppleTalk or Other Network: Fig. 2(c)) that communicate the test data to a computer that is executing the instructions of the portable media product (FIGS 2(b)-2(c) and Col.3: 28-30).

Regarding Claim 49, Corder further discloses instructions for recommending, based on the scores (i.e., performance(s)) of the one or more tests, one or more training modules for improving a reading or pre-reading skill of the individual as indicated by the score of the tests (Col.8: 45-51 and Col.16: 24-42).

Regarding Claim 52, Corder further discloses instructions for receiving a verbal response from the user to the one or more tests using speed recognition (Col.3: 67-Col.4: 4, Col.10: 36-44, and FIG 2(a), component 242 & Digitally recording of voice requires the recognition of speech and the digitized interpretation thereof).

Regarding Claims 53-57 & 59, Corder further discloses instructions to generate one or more tests comprising a rhyme recognition test for testing the ability to recognize rhymes (col. 13: 64), a rhyme generation test for testing the ability to generate rhymes (col. 14:4), a beginning and ending sound recognizer for testing the ability to recognize the beginning and ending sounds of a word (col. 14: 1 & 2), a word decoder test for

testing the ability to read by sounding out a written word, a sound blender test for testing the ability to blend sound units together to form words, a sound segmenting test for testing the ability to segment a sound unit into smaller sound units (col. 14: 5), a sound manipulator test for testing the ability to manipulate sound units to form a new unit, a sequential verbal recall test for testing the ability to recall a sequence of spoken items, a rapid naming test for testing the ability to rapidly name one or more items, and a letter naming and symbol/sound association test for testing the ability to name letters and identify the association between a symbol and an associated sound (i.e., using rhyming words to complete sentences & Col.14: 4).

Regarding Claim 62, Corder discloses means (i.e., voice recording device) for speaking the verbal response into the speech recognition device for receiving and interpreting a verbal response from the user (Col.3: 67-Col.4: 4, Col.10: 36-44, and FIG. 2A, component 242 & Digitally recording of voice requires the recognition of speech and the digitized interpretation thereof).

Regarding Claim 66, Corder discloses wherein the instructions on the portable media further comprises means for motivating the user to complete the tests (e.g., environmental sounds) (Col.13: 32-41).

Regarding Claim 67, Corder discloses wherein the motivation instructions comprise instructions for generating a graphical image and an associated sound to motivate the user to complete the test (Col.14: 45-48).

Regarding Claim 68, Corder discloses wherein the motivation instruction comprises means for generating the graphical image and associated sound after a first

predetermined number of tests are completed and means for generating another graphical image and associated sound after a second predetermined number of test are completed (Col.14: 19-26).

Regarding Claim 70, the motivation instructions further comprises instructions in Corder is capable of comprising means for generating the graphical image and associated sound after a third predetermined number of tests (Col.14: 19-26).

Regarding Claim 71, Corder discloses wherein the recommending instructions further comprises instructions for downloading (i.e., network) the recommended training module from the teacher station to the student computer (FIG 2(c)).

Regarding Claim 72, Corder discloses wherein the recommender further comprises instructions for storing (i.e., storage means) the incorrect responses to the one or more test and means (i.e., preliminary evaluation) for generating a training module recommendation based on the incorrect responses (Col.3: 28-30 and Col.8: 47-51).

Regarding Claims 73 and 74, Corder discloses wherein the recommender further comprises instructions for comparing each incorrect response (i.e., number of unsuccessful tries) to one or more error measures (inherent) to identify an error (e.g., deficiency in identifying certain sound/object pairs) associated with each incorrect response and instructions for generating a training module recommendation based on the identified error (Prescribe Module 412) and instructions for generating a training module recommendation based on the identified error and wherein the comparing instructions further comprises instructions for identifying one or more errors for each incorrect response (i.e., analyze module) (Col.16: 63-Col.16: 3, 24-42).

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Regarding Claim 75, Corder discloses wherein the recommender further comprises instructions for identifying a deficient skill by comparing the identified error to a deficient skill rule (inherent feature because in order to prescribe a remediation module the first element that needs to be known is what the user is deficient in which will then determine the appropriate remediation) and means for generating a training module recommendation based on the identified deficient skill (i.e., prescribe module) (Col.16: 24-36).

Regarding Claim 76, Corder discloses wherein the teacher station further comprises instructions for dynamically generating one or more data reports that illustrate the data associated with the one or more tests (e.g., recording the student's responses to the stimuli through the input means to the storage means of the computer) (Col.3: 29-30 and Col.8: 21-28).

Regarding Claim 80, Corder discloses wherein the data report generator further comprises instructions that generate a user interface (e.g., a copy of the test screen) for browsing other test data for a user (Col.12: 36-42).

Regarding Claim 81, Corder discloses wherein the data report generator further comprises instructions (e.g., a bar chart) for determining the number of user test results shown (Col.12: 36-42).

Regarding Claim 82, Corder discloses wherein the data report generator further comprises instructions (i.e., LaserWriter II NT Printer) for permitting the user to select a data report print format (e.g., bar chart) (Col.12: 36-42 and FIG. 2(c)).

Regarding Claim 83, Corder discloses wherein the data report generator further comprises instructions for permitting the user to select a data report display format (e.g., bar chart). This would have been an inherent feature of Corder's invention (Col.12: 36-42) because since the student can click with the mouse then the data report can also be clicked in order for the bar chart to be displayed on the screen. A selection must be made in order to display the bar chart.

Regarding Claim 84, Corder discloses wherein the data report generator further comprises instructions for generating a data report (i.e., student's performance) for one or more students in a class, means (e.g., analyze module) for generating a data report for one or more classes each having one or more students and means for generating a data report for a school having one or more classes (Col.8: 21-27 and Col.16: 36-42).

Regarding Claim 85, Corder further discloses instructions for communicating the response for each test for each student back to the server computer (FIGS 2(b)-2(c) and Col.3: 28-30).

Regarding Claim 87, Corder discloses wherein each student computer further comprises instructions for connecting to the teacher station and means for downloading the resources necessary to execute the current test when the test is started (i.e., AppleTalk or Other Network) (FIG. 2(c)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Protopapas et al. (US 5,868,683).

Regarding Claims 50 and 51, Corder does not disclose expressly further comprising instructions for generating a questionnaire (i.e., RD-predictive acoustical test) having one or more questions (i.e., asking the user to respond whether they perceive a pair of tonal stimuli to have the same or different frequencies) for eliciting information about risk factors (e.g., difficulties in mapping a particular sound to a speech sound in the mind) associated with language-based learning disabilities and wherein the information comprises historical data about reading-related risk factors including one or more of medical conditions including chronic otitis media, family history data including history of dyslexia, environmental data including socioeconomic status and exposure to literacy at home and observational data (i.e., a person encountering difficulty in mapping a particular spoken sound to a speech sound in the mind) about an individual's behavior reflecting competencies in speech and sound awareness. However, Protopapas teaches such in Col.4: 11-24 and Col.5: 27-36. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Corder, in light of the teaching of Protopapas in order to make a reasonable accurate prediction to the tester's susceptibility to reading deficient (RD).

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9. Claims 58 & 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Block et al. (US 6,305,942).

Regarding Claim 58, Corder does not disclose expressly wherein the tests further comprise a sound blender test comprising means for generating at least two sound stimuli and means for receiving a user response to the at least two stimuli, the response indicating an ability to blend the at least two sound stimuli into a larger sound unit.

However, Block teaches such (i.e., The highlighting cursor is utilized in the video and the interactive computer display to help students learn how the sounds blend with the words ... each sound of the combination of sounds is audibly demonstrated. Next the entire word is stated for the student to repeat.). See Col.7: 1-9. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate a sound blender test into the method and system of Corder, in light of the teaching of Block, in order to help students learn how sounds blend with words.

Regarding Claim 60, Corder does not disclose expressly wherein the tests comprise a sound manipulation test comprising means for generating a sound stimulus having one or more sound units and means, in response to the sound stimulus, for manipulating the sound units of the sound stimulus to test the ability to manipulate sound units.

However, Block teaches such (i.e., Next the entire word is stated for the student to repeat. Students then read and write the words in their workbooks, so they know how to spell them). See Col.7: 1-9. The student's mouth (used to repeat) and the writing mechanism the student uses to write the words are considered to be means for manipulating sound units. Therefore, at the time of the invention, it would have been

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obvious to one of ordinary skill in the art to incorporate a sound manipulation test into the method and system of Corder, in light of the teaching of Block, in order to help students learn how sounds blend with words.

10. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Jenkins et al. (US 6,331,115).

Regarding Claim 61, Corder does not disclose expressly a verbal recall test comprising means for generating at least one sound stimulus and means, in response to the at least one sound stimulus, for receiving a user response indicating the recalling of at least one sound stimulus (i.e., via selecting at least one corresponding tile that plays the same auditory phoneme). However, Jenkins teaches such in Col.3: 31-41. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into the method and system of Corder, in light of the teaching of Jenkins, in order to train short-term memory.

11. Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Corder (US 5,302,132), hereafter referred to as '132.

Regarding Claim 63, Corder does not disclose expressly wherein the tests further comprise a naming test comprising means (i.e., first phonogram screen) for generating at least one visual stimulus (e.g., "b") and means, in response to the display of the visual stimulus, for speaking the name of or the sound associated with the visual stimulus (i.e., microphone) using the speech recognition device (i.e., voice analysis). However, '132 teaches such in Col.20: 5-50. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the

aforementioned limitations into the method and system of Corder, in light of the teaching of '132, in order to teach phonics.

12. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Walker (US 5,421,731).

Regarding Claim 64, Corder does not disclose expressly a word decoder test comprising means for displaying a visual stimulus to the user and means, in response to the visual stimulus (i.e., a word), for receiving a response from the user to determine the ability to read the visual stimulus (i.e., verifying a pronunciation of a word). However, Walker teaches such in Col.1: 49-57 and Col.2: 5-9. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate a word decoder test into the method and system of Corder, in light of the teaching of Walker, in order to teach reading.

13. Claims 69 and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Truluck et al. (US 6,353,447).

Regarding Claims 69 and 77-79, Corder does not disclose expressly wherein the generating instructions further comprises instructions for generating a graphical image indicating the number of tests (i.e., activities) remaining to be completed, wherein the data reports further comprises instructions for displaying the test results (i.e., scores) simultaneously for one or more students, wherein the displaying instructions further comprises instructions for displaying the percentage of correct responses (i.e., percentage correct) for a test, wherein the displaying means further comprises instructions for displaying the results for one or more different test for each user wherein

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the results for each test are displayed in a different color (i.e., completed activities are displayed differently (e.g., shaded or different color) from incomplete activities).

However, Truluck teaches such in FIG.6, Col.1: 48-55, and Col.5: 23-67-Col.6: 15.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Corder, in light of the teaching of Truluck, in order to indicate a user's progress.

14. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Haff et al. (US 6,219,669).

Regarding Claim 86, Corder does not disclose expressly wherein the teacher station further comprises means for detecting a break in the communication between the teacher station and the server computer and means for resending any test data that was not sent due to the communications break. However, Haff teaches such in Col.28: 14-26. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into the method and system of Corder, in light of the teaching of Haff, in order to resume the transmission of a file depending on what portion of the file was previously received.

15. Claims 88-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Remschel (US 6,411,796).

Regarding Claims 88-91, Corder does not disclose wherein the teacher station further comprises instructions for generating a classroom layout showing an icon for each student computer (i.e., an illustration of the main window of the software showing seat numbers of the student stations), wherein the teacher station further comprises

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instructions for monitoring each student's test progress (Col.7: 13-15) and controlling each student computer (i.e., graphical user interface), wherein the teacher station further comprises means (i.e., storage means) for collecting student test data and wherein generating the layout further comprises instructions for coloring each icon depending on the state of testing for the particular student computer. However, Remschel teaches such in FIG. 7, Col.3: 19-20, Abstract, and Col.6: 12-25 & Col.12: 11-25, 46-50. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Corder, in light of the teaching of Remschel, in order to enable ease of use of the learning system.

16. Claims 92-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Sonnenfeld (US 6,112,049).

Regarding Claims 92-94, Corder does not disclose expressly wherein the teacher station further comprises instructions for generating one or more separate accounts, wherein the accounts include a lead teacher (e.g., test administrator) for managing the use of the diagnostic system by one or more classroom teachers in a particular school and one or more classroom teachers who each administer the diagnostic testing for a particular class of students, wherein the teacher station further comprises instructions for each lead teacher to register one or more classroom teachers who administer the test and instructions for each classroom teacher (e.g., test designer) to register one or more students who are taking the test and wherein the lead teacher has access to testing data for the entire school and each classroom teacher has access to testing data

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for the students in the class of the classroom teacher. However, Sonnenfeld teaches such in Col.9: 64-65 and Col.15: 33-37, 55-57. The lead teacher and the classroom teacher are considered a part of upper management. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Corder, in light of the teaching of Sonnenfeld, in order to provide an automated testing system allowing design and administration of hierarchical testing scheme.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ciarallo et al. (US 6,704,541)
 - Tracking the progress of students in a class

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kesha Frisby whose telephone number is 571-272-8774. The examiner can normally be reached on Mon. - Wed. 7-3pm, Thu. 7-4pm & Fri. 7-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyf

Kyf 10/4/2006

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PRIMARY EXAMINER